

REMARKS

Claims 1-42 are pending. Claim 20 has been amended.

5 Petition for Extension of Time

A petition for a 1-month extension of time and the extension of time fee is included with this amendment.

Applicant respectfully requests approval of this petition.

10 Fees

It is not believed that any further fees are necessary at this time. However, in the event additional fees are required, Applicants authorize the Commissioner to take any necessary fees, including those under 37 CFR 1.16 and 1.17, from deposit account 50-0913.

15 A Brief Review of One Embodiment of Applicants' Invention

In one embodiment of Applicants' invention, a gaming device includes at least one bonus display that may have a plurality of bonus prize displays and at least one moveable indicator.

The indicator is preferably adapted to move relative to the bonus prize displays and selectively indicate at least one of the bonus prize displays by moving proximate the position of the

20 indicated bonus prize display. A player input device allows the player to stop the moveable indicator. A controller is in communication with the moveable indicator. The controller is configured to detect a bonus activating event, determine a bonus prize, and cause a bonus prize display proximate the moveable indicator to convey the bonus prize. (see figures 1-3 and pages 9-13).

In another embodiment of Applicants' invention, a method of playing a game is disclosed. The method includes providing several bonus prize displays. Each bonus prize display may be configured to display a bonus prize. A player is allowed to place a wager and play a game. A player input device may be provided and a bonus activating event may be produced. A moveable bonus indicator is provided and the player is allowed to stop the moveable bonus indicator by providing input through the player input device. At least one of the bonus prize displayed is indicated using the moveable bonus indicator. A bonus prize may be determined and awarded to the player. (see figures 4 and 7 and pages 11-13 and 16-17).

10 **Rejection under 35 U.S.C. § 103(a)**

The Office rejected claims 1-42 under 35 U.S.C. §103(a) over Baerlocher (U.S. Patent 5,788,573) in view of Kelly (U.S. Patent 6,015,344). Baerlocher allegedly disclose an electronic game method and apparatus with hierarchy of simulated wheels. Kelly allegedly discloses a prize redemption system for games. Applicants respectfully traverse this rejection.

15 Neither Baerlocher nor Kelly anticipates the independent claims of the present invention for at least the following reasons:

- o Neither Baerlocher nor Kelly teach a gaming device that combines a plurality of bonus displays with a moveable indicator that moves proximate the bonus displays.
- o The combination of Baerlocher and Kelly teaches away from the Applicants
20 invention.
- o The combination of Baerlocher and Kelly is not obvious.
- o The combination of Baerlocher and Kelly can only be gleaned through hindsight reasoning.

Neither Baerlocher nor Kelly teach a gaming device that combines a plurality of bonus displays with a moveable indicator that moves proximate the bonus displays.

Baerlocher purports to disclose an electronic game method and apparatus with hierarchy of simulated wheels. Baerlocher appears to allow a player to play a game that has three prize wheels. The pointing device of Baerlocher is fixed and does not move. Kelly purports to disclose a prize redemption system for games. Kelly appears to show a video wheel with a video pointer that highlights portions of the wheel.

Each of independent claims 1, 20, 32 and 37 of Applicant's application specifically requires a moveable indicator that can move proximate or adjacent to the bonus prize displays.

The device of Baerlocher has fixed pointers 406a, b and c (figure 3) or 608a, b and c (figure 6) that do not move. The device of Kelly has a video display 506 that can display an image 518 of a playing field 520 and pointer 526 (figure 11b, 11c and column 48, lines 18-22 and column 49, lines 1-14. Pointer 526 is displayed within playing field 520 as a video pointer 526 by highlighting portions of playing field 520 on the video display.

A video pointer 526 as disclosed in Kelly cannot be mounted proximate or adjacent to a bonus display because, the pointer is part of or within the video display. Therefore, the pointer, as taught by Kelly, cannot be separate from the display as Kelly discloses the pointer being an image on the display.

In addition, the apparatus of Baerlocher does not operate in a manner where all three of the simulated wheels 402a, b and c are active at the same time. As shown in figure 1 and described in column 8, lines 1-58 of Baerlocher, the simulated wheels are spun in sequence. If the result of the first spinning wheel 402a is a bonus indicium 136, second wheel 402b is activated and can be played. If the outcome of second spinning wheel 402a is a bonus indicium

144, wheel 402c is activated and can be played. Therefore, only one of the simulated wheels 402 can display a prize at any one time.

Each of independent claims 1, 20, 32 and 37 of Applicant's application specifically require a plurality of bonus prize displays.

5 Baerlocher only teaches the use of a single prize wheel that can display a prize at any given time.

The dependent claims add additional patentable features and are allowable with the independent claims. For example, claims 10 and 11 recite that a worm gear and motor form a drive mechanism that can move the indicator. None of the cited references teach such a drive
10 mechanism.

The combination of Baerlocher and Kelly teaches away from the Applicants invention.

The combination of cited references fails to anticipate the claimed present invention of at least independent claims 1, 20, 32 and 37. If the prize wheels of Baerlocher were combined with
15 the video pointer as shown in Kelly, the combination could only result in a video pointer being shown on the same video display containing one prize wheel. Since, Baerlocher only teaches the use of one prize wheel to display a prize, the combination would require the use of only one prize wheel.

In contrast, applicant's invention uses a separate physically movable indicator that is
20 mounted adjacent or proximate but separate from several prize displays.

Further, the combination of Baerlocher and Kelly would require that the game player be allowed to determine the game outcome. The device of Kelly discloses a skill game. The game

player's skill or ability to determine when to press the stop button 500 determines when pointer 526 stops moving and the prize or game outcome (see column 49, lines 9-13 of Kelly).

The independent claims of Applicant's invention recite that a controller determines the bonus prize or that the prize is determined after the player has made a selection using a player
5 input device. This is very different from the teaching of Kelly in which the player is allowed to directly select a prize based on the player's skill. In the present invention, a controller, not the game player, determines the prize of Applicant's invention.

It is therefore respectfully submitted that the references teach away from the alleged combination. The courts have long cautioned that consideration must be given where the
10 references diverge and teach away from the claimed invention. *Akzo v. International Trade Commission*, 1 USPQ 1241, 1246 (Fed. Dir. 1986).

The combination of Baerlocher and Kelly is not obvious.

As the Court of Appeals for the Federal Circuit has noted, even if prior art references are
15 combinable to construct an Applicant's invention, the modification is not obvious unless there is a suggestion in the prior art. *In re Laskowski*, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989).

Applicant respectfully submits that there is no motivation or suggestion in either Baerlocher or Kelly to modify Baerlocher to include a separate physical pointer that is mounted proximate or adjacent a prize display and that the claims are patentably distinguishable over the
20 art of record.

Particularly, it is noted that Baerlocher does not recognize the solutions which Applicant's invention provides; i.e., the use of a plurality of prize displays to show a game player possible game outcomes at the same time. Baerlocher does not suggest or recognize these

problems or solutions. Had Baerlocher (instead of Applicant) recognized this, he would have disclosed a game with multiple prize displays.

The combination of Baerlocher and Kelly can only be gleaned through hindsight

5 reasoning.

The Federal Circuit has also stated that either a showing of some objective teaching in the prior art or the knowledge generally available to one of ordinary skill in the art must lead an individual to combine the relevant teachings of the references. *In Re Fine*, 837 F2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) (citing *In Re Lulu*, 747 F2d 703, 705, 223 USPQ 1257, 1258
10 (Fed. Cir. 1988). A rejection based on §103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, there is an initial burden of supplying the factual basis for the rejection advanced. One may not, because of doubt that the invention is patentable, resort to speculation, unfound assumption or hindsight reconstruction to supply deficiencies in the factual basis. See *In re*
15 *Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967).

It is doubtful that one skilled in the art of designing games would be motivated or inclined to look at games in which a player is allowed to determine the game outcome, such as shown in the device of Kelly, in order to design games in which a computer or controller determines the outcome of a game.

20 The specification of Kelly describes the use of the prize redemption apparatus in arcades. Games found in arcades are very different than those found in casinos. The device of Kelly can be characterized as a skill game. The game player's skill or ability at determining when to press the stop button determines the prize or game outcome. Because skill games are not considered

wagering games, one skilled in the art would be especially observant to avoid the use of an arcade type skill game, such as disclosed by Kelly, when designing new casino games.

As described above, it would appear that the obviousness determination was reached only after having considered the subject of Applicant's invention rather than the teachings of the prior art or the knowledge of those of ordinary skill in the art.

Because the cited references do not teach, disclose or suggest all limitations of Applicant's claims, Applicants respectfully request the Office to withdraw the §103(a) rejection.

Conclusion

For all of the above reasons, the Applicants submit that the present application is in condition for allowance. If the Examiner has any questions regarding the application or amendment, the Examiner is encouraged to call the Applicants' attorney at (775) 826-6160.

Respectfully Submitted,

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